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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,362

06/26/2003

Patrick Miles

023US1

2877

30328 7590 02/20/2007

JONATHAN SPANGLER

NU VASIVE, INC.

4545 TOWNE CENTRE COURT

SAN DIEGO, CA 92121

EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

NT

Office Action Summary	Application No.	Applicant(s)	
	10/608,362	MILES ET AL.	
	Examiner	Art Unit	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,5-14,16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7,11-14 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 2,8-10 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/22/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, lines 2,3, the term "said initial distraction assembly" lacks prior antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 8-10, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Koros et al. (6,139,493).

With respect to claim 2, Koros et al disclose a system for accessing a surgical target site, comprising an initial distraction system (10) for creating an initial distraction corridor, wherein the initial distraction assembly includes a K-wire (82,83) and at least one dilator (32) capable of being slidably passed over the K-wire to perform the initial distraction; and an assembly (12) capable of distracting from the initial distraction corridor to a secondary distraction corridor and thereafter sequentially receiving a plurality of retractor blades (30) for retracting from the secondary distraction corridor to

thereby create an operative corridor to the surgical site; as set forth in column , lines 19-67, column 4, lines 1-67; column 5, lines 54-67, column 6, lines 1-67, column 7, lines 13-33, and as best seen in the FIGS.

With regard to the limitation that an element is capable of performing a function, it is noted that this is not a positive limitation and does not constitute a limitation in any patentable sense. It is only required that the reference is capable of performing the function as claimed by applicant.

With respect to claims 8-10, Koros et al discloses all the limitations, as set forth in column 3, lines 19-67, column 4, lines 1-67; column 5, lines 54-67, column 6, lines 1-67, column 7, lines 13-33, and as best seen in the FIGS.

The method steps, as set forth, would have been inherently carried out in the operation of the device as set forth above.

Claims 2, 8-10, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer et al. (5,728,046).

With respect to claim 2, Mayer et al disclose a system for accessing a surgical target site, comprising an initial distraction system (1,5) for creating an initial distraction corridor, wherein the initial distraction assembly includes a K-wire (36) and at least one dilator (32) capable of being slidably passed over the K-wire to perform the initial distraction; and an assembly (2,3,4) capable of distracting from the initial distraction corridor to a secondary distraction corridor and thereafter sequentially receiving a plurality of retractor blades (7,18,19) for retracting from the secondary distraction corridor to thereby create an operative corridor to the surgical site; as set forth in

column 2, lines 43-67, column 3, lines 1-67; column 4, lines 1-12, and as best seen in the FIGS.

With regard to the limitation that an element is capable of performing a function, it is noted that this is not a positive limitation and does not constitute a limitation in any patentable sense. It is only required that the reference is capable of performing the function as claimed by applicant.

With respect to claims 8-10, Mayer et al discloses all the limitations, as set forth in column 2, lines 43-67, column 3, lines 1-67; column 4, lines 1-12, and as best seen in the FIGS.

The method steps, as set forth, would have been inherently carried out in the operation of the device as set forth above.

Allowable Subject Matter

Claims 5-7, 11-14, 19-21 are allowed.

Response to Amendment

Applicant's arguments with respect to claims 2,8-10,16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-

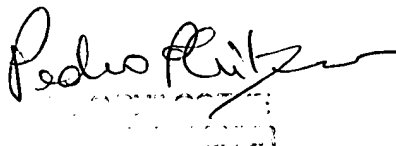
Art Unit: 3733

4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
February 12, 2007

A handwritten signature in black ink, appearing to read "Pedro Philogene", is written over a rectangular stamp. The stamp contains some illegible text and a date, possibly "FEB 12 2007".